

A33403-PCT-USA-A 072854.0114
PATENTREMARKS

Claims 75-85 and 87-88 are pending. Applicants have amended claim 87 herein to independent form. Thus, claims 75-85 and 87-88 will remain pending upon entry of this amendment.

Applicants respectfully request entry of the amendments and remarks presented herein pursuant to 37 C.F.R. § 1.312. This paper is being filed on the same day as the payment of the Issue Fee, albeit under separate cover. Nevertheless, Applicants believe that this satisfies the requirement for being filed "with the payment of the issue fee". *See e.g.* MPEP § 714.16 ("Finally, it is pointed out that an amendment under 37 C.F.R. 1.312 must be filed on or before the date the issue fee is paid").

The Manual of Patent Examination Procedure § 714.16 provides that an amendment to the claims must be accompanied by a statement fully and clearly state the reasons on which reliance is placed to show:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.

Accordingly, Applicants hereby state that:

- (A) Claim 87, in its present form is dependent on claim 75 (via claim 81), which recites " $X= OH, OMe$ or $N(CH_3)_2$ ". However, the corresponding group in structures XXXI and XXXII is H (a hydrogen). Consequently, a correction is necessary to correct this inconsistency.

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(B) Claim 87, as amended herein, is not different in scope from the subject matter that the Examiner has already searched and considered. The correction goes to a mere formality and does not require additional searching or examination.

(C) The prior art of record in the instant application does not teach or suggest a CYP1B1 substrate having the structure of XXXI or XXXII, as clearly reflected in the prosecution history of the application.

(D) In the Request for Reconsideration with Technical Amendments filed June 4, 2002, claim 37, an earlier version of claim 75, was amended, in part, as follows

$$X = H, OH, OMe \text{ or } N(CH_3)_2$$

Claim 48, the earlier version of claim 87, was dependent on claim 37 (via claim 47), but was inadvertently not amended to account for the amendment to claim 37. This error was inadvertently carried over when new claim 87 was presented. The error was only discovered upon review of the claims that have been deemed allowable after the Amendment of October 17, 2003 was filed.

In view of these remarks, Applicants believe that the instant amendment may properly be entered.

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Applicants do not believe that any fees are required with this paper. Nevertheless, the Commissioner is hereby authorized to charge any fees occasioned by this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Please credit any overpayment of fees associated with this filing to the above-identified deposit account. A duplicate of this page is enclosed.

Respectfully submitted,
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